

REMARKS

The allowance of claims 1 - 8, 11 and 12 is acknowledged.

By the present amendment, new dependent claims 14 - 16 have been presented wherein claim 14 depends from claim 10 and claims 15 and 16 depend from claim 13 directly or indirectly.

The rejection of claim 10 under 35 USC 102(b) as being anticipated by Van Osenbruggen (US 2002/0131267 A1) and the rejection of claim 13 under 35 USC 102(b) as being anticipated by Davis (US 6,565,227 B1), such rejections are traversed and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Turning to claim 10 and the rejection as being anticipated by Van Osenbruggen, the Examiner contends that Van Osenbruggen discloses a power tool

having an end output unit (402) and that the field of invention includes electric drivers or drills (paragraph 0001) that drive fasteners, and it is considered inherent that this light unit is also applicable to power tools that drive fasteners. Applicants submit that contrary to the position set forth by the Examiner, each of the recited features of claim 10 is not found in Van Osenbruggen. More particularly, claim 10 recites the feature of "a body housing the motor and having an end output unit for chucking an end tool driving a fastener" (emphasis added) as well as "a light unit disposed to one of the handle grip and the body, and having a light-emitting element for illuminating a fastener located on a distal end of the end tool, the end tool being driven by the motor to tighten the fastener to a workpiece" (emphasis added). Applicants submit that such features are not disclosed or inherent in Van Osenbruggen. While the Examiner refers to an end output unit by reference numeral 402, in Figures 3 and 4 of such patent publication, "402 is a spindle" as described in paragraph [0073], and would appear to correspond to a spindle having a thread 203 for enabling screwing into a threaded aperture, as described in connection with Figure 2 in paragraph [0072]. Although the Examiner also refers to an abrasive disk (307) in Figures 3 and 4, it is noted that Figures 5 and 6 describe a standard stud 503 for threading the handle onto the body of a unit, as described in paragraphs [0078] and [0079]. Thus, irrespective of the contentions by the Examiner that the invention of Van Osenbruggen may be applicable to electric drills or drivers, there is no disclosure in Van Osenbruggen, in the sense of 35 USC 102 of the recited features of claim 10, as pointed out above, such that applicants submit that the rejection of claim 10 under 35 USC 102 is improper, and claim 10 patentably distinguishes over Van Osenbruggen in the sense of 35 USC 102 and should be considered allowable thereover.

As to any suggestion by the Examiner that it would be obvious to provide the claimed features of claim 10 based upon Van Osenbruggen, applicants submit that Van Osenbruggen does not disclose or teach the aforementioned features of claim 10 in the sense of 35 USC 103 and claim 10 also patentably distinguishes over Van Osenbruggen in the sense of 35 USC 103.

Applicants note that by the present amendment, new dependent claim 14 has been presented, which further defines the transverse location of the handle with respect to an elongated extension direction of the body, with the end output unit for chucking and end tool for driving the fastener extending in the elongated extension direction of the body, as clearly illustrated in the drawings of this application, and such features are also not disclosed or taught by Van Osenbruggen in the sense of 35 USC 102 or 35 USC 103. Thus, claim 14 should also be considered allowable thereover.

As to the rejection of claim 13 as being anticipated by Davis, applicants note that claim 13 recites the feature of a body having an end output unit for chucking an end tool driving a fastener, as well as "a handle grip provided integrally with the body, the handle grip extending generally perpendicular to the body with providing a protective space surrounded by the handle grip and the body" (emphasis added) and "a pull trigger is disposed at a top part of the handle grip for starting/stopping driving of the end tool, the light unit being disposed within the protective space and at a position below the body and above the trigger" (emphasis added). Applicants note that such features are illustrated in Figures 11 and 12 of the drawings of this application and as described at pages 37 - 39 of the specification, for example. As illustrated and described at page 37, lines 22 - 24 of the specification, the light unit 220 is disposed immediately above the trigger 213 and has one light-emitting

element 223 originated to the front of the body 210". (emphasis added).

Furthermore, as described at page 38, line 17 to page 39, line 3, when the user extends the index finger towards the front of the bit 103 from the position gripping the handle grip 210c, the finger will not touch the light unit 220 because the light unit 220 is located directly above the trigger 213 and the light unit 220 thus does not interfere with the operation of the trigger 213 and the operability to the power tool 201 can be improved. Thus, it is apparent that a protective space is provided, where the light unit is located, which protective spaces are surrounded by the handle grip and the body, and the light unit is disposed at a position below the body and above the trigger, which is located at the top part of the handle grip, as recited in claim 13. Moreover, since the light unit 220 does not project outside from the body 210 and the light unit 220 does not contact the neighboring or opposing member or get in the way, even when using the power tool in a confined location, the light unit is provided in the protective space as described in the paragraph bridging pages 38 and 39 and recited in claim 13.

Irrespective of the position set forth by the Examiner, while Figure 4 of Davis discloses a handle grip integral with the body (212) and having a trigger at a top part of the handle grip, assuming arguendo, that a protective space is formed which is surrounded by the handle grip and the body, applicants submit that such protective space in Davis is necessarily located in the vicinity of the trigger as delimited by the combination of the handle grip and the body. As to the Examiner's contentions, of "the light unit (210) being disposed within the protective space and at a position below the body (212) and above the trigger (Fig. 4)" applicants submit that the light unit 210 of Davis is not within the protective space formed by the combination of the handle grip and the body, noting that the light unit 210 is not located in the vicinity of

the handle grip in Fig. 4 of Davis, nor is the light unit (210) positioned above the trigger of the handle grip and below the body in the proximity of the handle grip, nor above the trigger within the protective space, as defined. Thus, applicants submit that Davis does not disclose the recited features of claim 13 in the sense of 35 USC 102. Additionally, applicants note that while Davis discloses a drill with a drill bit 216, as shown in Fig. 4 thereof, Davis describes the drill 216 being utilized for drilling holes and fails to disclose or teach an end output unit for chucking an end tool driving a fastener and enabling tightening of the fastener to a workpiece, in the manner recited in claim 13. Thus, applicants submit that claim 13 patentably distinguishes over Davis in the sense of 35 USC 102, and applicants further submit that it cannot be considered obvious in the sense of 35 USC 103 to provide Davis with the recited features of claim 13 and claim 13 should be considered allowable at this time.

Applicants note that new dependent claims 15 and 16 have been presented which depend from claim 13 with claim 15 reciting the feature that the light unit is disposed immediately above the trigger, which feature is not disclosed or taught in Figure 4 of Davis, and is contrary to the disclosure thereof. New dependent claim 16 depends from claim 15 and further defines the location and projection of the light unit with respect to the trigger in the non-activated state thereof such that it is readily apparent that features of claim 16 are also not disclosed or taught by Davis, and applicants submit that the dependent claims 15 and 16, when considered in conjunction with parent claim 13, further patentably distinguish over the cited art and should be considered allowable.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 1297.43994X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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